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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/927,022	09/10/1997	STEVEN T KIRSCH	INF-009	7872

7590 07/25/2005  
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EXAMINER

ABEL JALIL, NEVEEN

ART UNIT PAPER NUMBER

2165

DATE MAILED: 07/25/2005

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

08/927,022

Applicant(s)

KIRSCH, STEVEN T

Examiner

Neveen Abel-Jalil

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4-19 is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

## DETAILED ACTION

### Remarks

1. In response to Board of Patent Appeals and interferences' decision on the Appeal brief filed on March 08, 2005, the office action is presented herewith.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Porter et al. (U.S. Patent No. 5,845,067).

As to claim 1, Porter et al. teaches a document retrieval system with access control (See Porter et al. column 10, lines 29-44) for a search engine capable of searching documents distributed over web servers in an electronic network comprising,

one or more web servers (See Porter et al. column 15, lines 42-43, also see Porter et al. figure 6, 630, "server" containing 665 "Web info base") having electronic versions of documents (See Porter et al. column 10, lines 5-19) said documents each having a security level (See Porter et al. column 10, lines 29-61), with each document available by request (See Porter et al. column 6, lines 48-64),

a search engine (See Porter et al. column 6, lines 64-67, wherein "search engine" reads on information service 640", also see Porter et al. column 6, lines 10-12) having access to all documents on the web servers (See Porter et al. column 4, lines 1-5), the documents associated with an access control list (See Porter et al. column 10, lines 35-44, "ACL") linking the security level of users with the security level of documents on the web servers (See Porter et al. column 10, lines 20-49), with the web servers screening the search results with the access control list to determine the documents for which a user performing a search has access (See Porter et al. column 9, lines 46-59, also see Porter et al. column 10, lines 50-61, wherein "search" reads on "retrieves").

As to claim 2, Porter et al. teaches further defined by means for forwarding to the user only those document titles compatible with the authorized access of the user, wherein document titles (See Porter et al. column 11, lines 57-62) that are not compatible with the authorized access of the user are not forwarded to the user thereby preventing the user from discovering the

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existence of said document titles through the use of the search engine (See Porter et al. column 11, lines 53-65, also Porter et al. column 18, lines 45-53, wherein only verified according to search criteria are displayed are deemed to prevent files from being displayed/discovered and not forwarded as only those compatible are authorized to be accessed by the user).

As to claim 3, Porter et al. teaches further comprising a communications link between a query server, connected to the search engine (See Porter et al. column 6, lines 39-66, wherein "search engine" reads on information service 640"), and access control lists associated with the web servers (See Porter et al. column 10, lines 29-44).

#### Reasons for Allowance

4. Claims 4-19 are allowed over the prior art made of record.

5. The following is a statement of reasons for allowance:

The prior art of record (Schloss-U.S. Patent No. 5,706,507-Kirsch-U.S. Patent No. 5,751,956-and-DuFresne-U.S. Patent No. 5,835,715-and -Porter et al. -U.S. Patent No. 5,845,067) do not disclose, teach, or suggest the claimed limitations of (in combination with all other features in the claim), reviewing all URLs by the document servers after the search is executed using an access control list associated with each document server to check whether each URL is compatible with the access level of the identification code of the person executing the query, delivering only those URLs that are compatible with the access level of the person, wherein each URL that is not compatible with the access level of the person is withheld, and

preventing the person from discovering the URLs that are not compatible with the access level of the person, as claimed in Independent claim 4.

Claims 5-12 are allowable over the prior art made of record, because they are dependent from the allowable independent claim 4.

The prior art of record (Schloss-U.S. Patent No. 5,706,507-Kirsch-U.S. Patent No. 5,751,956-and-DuFresne-U.S. Patent No.5,835,715-and -Porter et al. -U.S. Patent No. 5,845,067) do not disclose, teach, or suggest the claimed limitations of (in combination with all other features in the claim), executing a query on a query server having access to a document index of documents available for searching on the document servers by a person having one of said identification codes, determining by one of the document servers whether each URL is compatible with the access level of the identification code of the person; and producing only those documents whose URL is compatible with the access level of the identification code of the person, wherein each non-compatible URL is withheld, as claimed in Independent claim 13.

Claims 14-19 are allowable over the prior art made of record, because they are dependent from the allowable independent claim 13.

*Conclusion*

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neveen Abel-Jalil whose telephone number is 571-272-4074. The examiner can normally be reached on 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Neveen Abel-Jalil  
July 18, 2005



PETER WONG, DIRECTOR  
TECHNOLOGY CENTER 2100